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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/431,849	11/02/99	NICKEL	BEIERSDORF-5

IM22/0117  
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EXAMINER  
FERGUSON, L

ART UNIT	PAPER NUMBER
1774	7

DATE MAILED: 01/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/431,849

Applicant(s)

NICKEL, OILVER

Examiner

Lawrence Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 November 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9, drawn to article, classified in class 428, subclass 343.
  - II. Claim 11, drawn to method, classified in class 427, subclass 208.4.
2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, invention I, is deemed to be useful as a heat resistant masking tape and invention II is deemed to be a method for using the article. However, Invention I can be used in various different methods; such as, home decoration.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with William C. Gcerstenzang's secretary on 09/27/2000 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office Action. Claims 11 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently name inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections USC 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- a. In claim 1, section a, the structure is not clear. How are the paper support and the self-adhesive composition affixed to the heat-resistant adhesive tape?
  - b. In claim 1, sections b and c, it is not clear what the term *duplexed* means.
  - c. In claim 1, section b, "the marginal area" lacks antecedent basis.
  - d. In claim 1, section d, what is the adhered state?

***Claim Rejections – 35 USC 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al. (US 5,385,783) in view of Sakumoto et al. (US 5,683,806).

10. Patel discloses a high temperature – resistant masking tape comprising a paper substrate, a release coat on one surface of said paper, and an adhesive on the other surface of said paper (abstract; col. 2, lines 1-5). Patel discloses a maximum heat resistance of 165°C (specification, col. 1, line 23). Patel discloses a tape comprised of conventional crepe paper (specification, col. 1, lines 59-60). Patel discloses a tape that is rolled up on a core (specification, col. 1, line 42). Patel does not disclose a film. While Patel does not disclose a specific width or thickness for the adhesive tape, he does state that the tape can be prepared into predetermined widths and lengths. Patel does not disclose that the masking film is folded. Patel does not disclose a polyolefin film.

11. Sakumoto teaches an adhesive tape comprising a heat resistant base film and a protective adhesive layer laminated on at least one surface of said base film (abstract, col. 2, lines 1-3). This protective laminated adhesive layer can be made out of polyolefin, such as polyphenylene (specification, col. 1, line 21). Sakumoto teaches that the protective layer has a thickness of from 1 to 200µm (specification, col. 2, line 54-55).

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12. Patel and Sakumoto are analogous art because they are from the same field of endeavor, that is masking tape. At the time of the invention, it is obvious to a person of ordinary skill in the art to combine the protective laminated adhesive layer of Sakumoto with the adhesive layer of Patel in order to provide protection for the adhesive layer of Patel so it would not lose its bonding properties.

13. Patel discloses the claimed invention except for the masking film being folded. It would have been obvious to one of ordinary skill in the art to have combined the teachings of Sakumoto with Patel because Patel discloses that the film can be rolled. If the film can be rolled, it can also be rearranged and/or folded. Since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305 - 9978. The examiner can normally be reached Monday through Friday 8:30 AM - 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Krynski can be reached on (703) 308-2376. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for after final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

*Ldf*

Ldf  
January 10, 2001

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